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Paper No. 9

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In re Application of	:	OFFICE OF PETITIONS
Chin-Chi Teng et al	:	
Application No. 10/043,458	:	DECISION GRANTING PETITION
Filed: January 9, 2002	:	UNDER 37 CFR 1.137(b)
Attorney Docket No. SILI 2282	:	

This is a decision on the petition, filed May 28, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for the failure to notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing. See 37 CFR 1.137(f).

The petition is GRANTED.

The instant application was filed on January 9, 2002, which included a nonpublication request to not publish the application. The nonpublication request stated:

It is hereby certified that the invention disclosed in the application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On January 8, 2003, applicant filed a counterpart international application relating to the subject matter of the above-identified application. Thereafter on January 27, 2003, applicant filed a Notice of Rescission of Nonpublication Request, but did not notify the USPTO that this application was being filed as a counterpart international application. Notification of the filing of the counterpart international application as required by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) was provided at the time of filing of the instant petition. As the notification to the USPTO of the foreign filing on January 8, 2003 of the counterpart international application did not occur within 45 days of such filing, this application is regarded as abandoned as of midnight on February 22, 2003.

Petitioner has filed the instant petition to revive as a conditional petition on the basis that the Office should accept, for the reasons noted in the petition, the previously submitted notice of January 27, 2003 rescinding the nonpublication request as an adequate notification under 35 U.S.C. 122(b)(2)(B)(iii), which is the principal petition in this case. Petitioner states that, in the event the principal petition is not granted, the applicant requests the Office to acknowledge that applicant has, in fact, filed a timely and explicit notification under 35 U.S.C. 122(b)(2)(B)(iii). In this regard, applicant's act of filing an international application in the USPTO in its capacity as Receiving Office should be considered the notification required. Alternatively, if conditional petition 1 is not granted, petitioner seeks, in conditional petition 2, revival pursuant to the provisions of 37 CFR 1.137(b)/(f).

35 U.S.C. 122(b)(2)(B) states, in pertinent part:

(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) **An applicant may rescind a request made under clause (i) at any time.**

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. **A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.**

(iv) If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

As to petitioner's arguments in the principal petition, the American Inventors Protection Act of 1999 required publication of certain patent applications filed on or after November 29, 2000, and allowed applicants to request nonpublication if the invention disclosed in the application had not been and would not be the subject of an application filed in another country, or pursuant to an international agreement that required publication of patent applications eighteen months after filing. The Act permitted applicants to rescind the nonpublication request at any time, but also required applicants to notify the USPTO if they had made a nonpublication request (with the certification that the invention disclosed in the application had not been and would not be "foreign filed," and then did foreign file). If an applicant requested nonpublication, and then did not provide notice of foreign filing no later than 45 days of the foreign filing, the statute provides that the application would be regarded as abandoned. An applicant who rescinded a nonpublication request after filing the U.S. application but before foreign filing the application is not understood to be required to also file a notice of foreign filing, since the rescinding of the nonpublication request prior to foreign filing would nullify the nonpublication request (if received in the USPTO prior to the date of foreign filing).

Further, petitioner is advised that, because the USPTO expected rescission (applicants who initially requested nonpublication, but later changed their mind as to the desire for nonpublication) to be an uncommon, but likely, event, the USPTO initially provided a form for rescission. The USPTO did not initially

provide a form for a notice of foreign filing, because the USPTO did not anticipate receiving many such notices since it would only be necessary if applicant had a change of heart and decided to file abroad after having made the decision not to file abroad when he initially filed in the United States. In general, the USPTO provides forms for common circumstances, but not for rare situations (as was not expected that many notices of foreign filing would be filed). The USPTO provides, as a courtesy, suggested forms for use. It is noted that USPTO's form for rescinding a nonpublication request, PTO/SB/36 (dated 4/01 or 10/01) provides a note that states "[f]iling this rescission of a previous nonpublication request is considered the notice of subsequent foreign or international filing required by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) if this rescission is filed no later than forty-five (45) days after the date of filing of such foreign or international application" instead of an affirmative statement. The USPTO form for a rescission can be accepted as a notice of foreign filing because it makes some mention of foreign filing. Applicant-created rescission forms that fail to include any indication from the applicant that the paper filed by applicant is intended also to be a notice of foreign filing under 35 U.S.C. 122(b)(2)(B)(iii) cannot be treated as a notice of foreign filing. An applicant who has removed the language on the form intended to provide notice of foreign filing cannot be considered to be providing such a notice when the applicant has done all that is possible to avoid providing a notice of foreign filing under 35 U.S.C. 122(b)(2)(B)(iii) to the USPTO. Applicant is reminded that the USPTO has no authority to waive a requirement of the patent statute. Thus, applicants are cautioned to familiarize themselves with the requirements of the patent statute to ensure that a submission, whether on a USPTO-provided form or an applicant-created form that is modeled after a USPTO-created form, meets the requirements of the patent statute that are applicable to the particular submission. The mere filing of a rescission does not imply that the invention has been or will be filed in another country, and instead suggests that the applicant now desires to have the application published so the applicant could take advantage of the provision rights provisions of the statute. For the above-stated reasons, if a rescission does not include any mention of a foreign filing, the rescission cannot be considered as a notice of foreign filing to satisfy the requirement of 35 U.S.C. 122(b)(2)(B)(iii). In view thereof, since applicant herein did not provide the required notice within 45 days, the application is regarded as abandoned.

Addressing petitioner's argument that no specific notice is required of the filing an international application since such filing in the United States Receiving Office was a notification of foreign filing within 45 days, this argument is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b) provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject, so a notification of foreign filing was required to be on a separate paper from another matter (such as a new application), and so the mere filing of the international application, which references the application number and filing date of the subject application, in the United States Receiving Office would not have been notice of foreign filing.

A review of the contents of the file of the above-identified application shows that no notification of the filing of the PCT application was filed within 45 days after the filing date of the PCT application. As a result of petitioner's failure to provide timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), the above-identified application became abandoned midnight February 22, 2003.

Turning lastly to conditional petition 2, a petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the Office of a foreign filing must be accompanied by:

- (1) notification of such filing in a foreign country or under a multinational treaty;
- (2) the petition fee as set forth in 37 CFR 1.17(m); and
- (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of November 6, 2003 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center Art Unit 2812 for appropriate action on the reply received June 16, 2003 to the nonfinal Office action of March 24, 2003.



Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request
and Notice of Foreign Filing